

REMARKS

The Office Action dated June 18, 2003 required restriction of the claims into 2 claim Groups. Group I consists of claims 1-15, 44 and 45, drawn to nucleic acids and vectors and host cells containing the nucleic acids, classified in Class 536. Group II consists of claim 16, drawn to a method of making a protein using nucleic acids, classified in class 435.

In response, Applicants elect Group I, namely claims 1-15, 44 and 45. However, Applicants do so with traverse. Applicants dispute the assertion by the Office that the 2 claim Groups involve separate and distinct inventions.

35 U.S.C. §121 provides that "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." M.P.E.P. §802.01 deviates from the plain meaning of "independent and distinct" by interpreting "and" to mean "or". The Parent Office relies on the absence from the legislative history of anything contrary to this interpretation as support for their position that "and" means "or". Applicants respectfully note that this position is contrary to the rules of statutory construction. Restriction between two dependent inventions is not permissible under the plain meaning of 35 U.S.C. §121. In this context, the Examiner does not assert that the inventions of the 2 claim Groups are independent. Rather, the Examiner alleges that the inventions of the 2 claim Groups are distinct because the product as claimed can be used in a materially different process of using that product.

Applicants further urge the Examiner take into consideration that the subject matter of each of the claim Groups is linked by a common inventive concept.

According to M.P.E.P. §803, there are two criteria for a proper restriction requirement. First, the two inventions must be independent and distinct. In addition, there must be a serious burden on the Examiner if restriction is not required. Even if the first criterion has been met in the present case, which it has not, the second criterion has not been met.

Applicants assert that a search into prior art with regard to the invention of the different Groups is so related that separate significant search efforts should not be necessary. Accordingly, there is no serious burden on the Examiner to collectively examine the different claim Groups of the subject application. Therefore, restriction is not proper under M.P.E.P. §803.

Consequently, Applicants respectfully request the Examiner reconsider and withdraw the restriction requirement. It is also submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

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